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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,448	12/30/1999	STUART LEE BRESLOW	4034-46	7867

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EXAMINER

RUDY, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/476,448

Applicant(s)

BRESLOW ET AL.

Examiner

Andrew Joseph Rudy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9-12,14-21,23 and 26-39 is/are pending in the application.

4a) Of the above claim(s) 29-39 is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,2,4-6,9-12,14-21,23 and 26-28 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 2, 4-6, 9-12, 14-21, 23 and 26-39 are pending.
2. Applicant, from the December 24, 2002 Amendment (Paper No. 10), canceled claims 3, 7, 8, 13, 22, 24, 25 and 40.

### ***Response to Amendment***

3. Applicant's election with traverse of Group I, claims 1-28 in Paper No. 10 is acknowledged. Inventions Group I and Groups II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Group I can be used to practice another invention, e.g. purchasing a consumer product.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and/or III, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Applicant's traversal is on the ground(s) that the Groups I, II, III and IV are not independent nor distinct from each other. This is not found persuasive because Groups II, III and IV are independent and distinct from Group I as "no transmission of a recap order by the on-line trading system" (Group II) nor is "checking for same side and opposite side orders" (Group III) nor "sending an intrusive alert" (Group IV) required from is required from the Group I claims. As is, each of these elements (and others) would require a separate search and/or consideration. Having a relationship that is "well-disclosed" is not the line of demarcation when determining whether the restriction is proper. Because each Group generally relates to on-line trading systems does not, in itself, negate the restriction requirement. Thus, claims 29-39 are withdrawn from consideration.

The requirement is still deemed proper and is therefore made FINAL.

7. Applicant's comments regarding "rule 105" are noted. No "rule 105" request was made by the Examiner. The Examiner is cognizant that Applicant is well within their rights in not commenting upon each reference submitted. However, given the extensive nature of the submission, helpful insight into the relevancy of each document submitted was at the heart of the

Examiner's inquiry. As is, Applicant's Information Disclosure Statement (IDS) has been reviewed. Note the initialed IDS. However, the "OTHER DOCUMENTS" were not reviewed, as none were included with the US references. It is noted that each document submitted under the "OTHER DOCUMENTS" was not properly listed on the IDS. Consultation with the MPEP regarding this issue is suggested if an attempt is made to resubmit each document.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features recited from the claims, e.g. the various servers must be appropriately labeled, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis, US 6,519,019. Lewis discloses, e.g. Figs. 4, 17 and 19, an on-line system for trading financial instruments over a computer network including a plurality of web clients 140, a plurality of servers, e.g. 105, 108, 111, 112, 120, 150 (see Fig. 4), a mainframe computer means and business rules, e.g. Fig. 19, deemed customizable, to allow a client to execute a sale or purchase of the financial products. To provide an advisor computer operated by a financial advisor for Lewis would have been obvious to one of ordinary skill in the art. Doing such would provide a well known client/financial advisor relationship that has been well established within the financial portfolio advice community. It is noted that cash and margin account trades are notoriously well known in the financial services industry and to have provided such for Lewis would have been

obvious to one of ordinary skill in the art. Likewise, to substitute the use of various well known servers, e.g. claims 4, 5, for Lewis, would have been obvious to one of ordinary skill in the art.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Further pertinent references of interest:

Clenaghan et al., US 2002/0052816, discloses spreadsheets, e.g. Fig. 2.

Chiasson, US 2002/0002513, discloses an interactive computer network, e.g. Fig. 1.

Schummer, US 2001/0032154, an on-line business rule 86 based e-commerce platform using a web browser.

Killeen, Jr. et al., US 6,324,523, discloses graphical user interfaces and financial reports.

Jones et al., US 6,021,397, discloses a financial advisory system.

Kitain et al., US 5,864,871, discloses a financial advisory system using a registry system.

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14. Applicant is requested to review the specification and insert, where appropriate, the appropriate symbols for service marks and trademarks, e.g. claims 4-6.

*Conclusion*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m..

If attempts to reach the examiner by telephone are unsuccessful, Mr. Richard Chilcot, can be reached on 703-305-7687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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February 4, 2003

*Andrew Joseph Rudy*

*Richard Chilcot*  
Supervisory Patent Examiner  
Technology Center 2800  
*2/6/03*